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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|----------------------------------|-------------|----------------------|---------------------|-------------------|
| 10/527,144 | 03/09/2005 | Ralf Diekmann | SCH-15851 | 9517 |
| 40854 | 7590 | 12/12/2007 | | EXAMINER |
| RANKIN, HILL, PORTER & CLARK LLP | | | | LEUBECKER, JOHN P |
| 38210 Glenn Avenue | | | ART UNIT | PAPER NUMBER |
| WILLOUGHBY, OH 44094-7808 | | | 3739 | |
| | | | MAIL DATE | DELIVERY MODE |
| | | | 12/12/2007 | PAPER |

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

| | | |
|------------------------------|------------------------|---------------------|
| Office Action Summary | Application No. | Applicant(s) |
| | 10/527,144 | DIEKMANN ET AL. |
| | Examiner | Art Unit |
| | John P. Leubecker | 3739 |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 09 March 2005.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-6 is/are pending in the application.
 - 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1 and 3-6 is/are rejected.
- 7) Claim(s) 2 is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 09 March 2005 is/are: a) accepted or b) objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

| | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date <u>3/9/05 & 4/28/05</u> . | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| | 6) <input type="checkbox"/> Other: _____ |

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1 and 3-5 are rejected under 35 U.S.C. 102(b) as being anticipated by Yabe et al. (U.S. Pat. 4,868,644).
3. Referring mainly to Figures 14 and 15 (which show different views of the same device), Yabe et al. disclose an endoscope comprising an image transmitting system (23,31), a fiber optics bundle (50) mounted in the endoscope (Fig.14) and illuminating the field of view (through either of windows 71), a light source (6, Fig.5, col.3, lines 52-53), and a light tapping system comprising an optical fiber that branches off of the fiber optics bundle (50) (note bifurcation and separate branch shown in Fig.14) which taps light from the fiber optics bundle and guides it to a window (the other of windows 71) in an external wall of the endoscope. Note that light tapping window (71) is in the zone and configured to illuminate a functional element (forceps extending from the forceps outlet 26).
4. Claims 1 and 3-6 are rejected under 35 U.S.C. 102(b) as being anticipated by Jacoby (U.S. Pat. 5,328,365).
5. Referring mainly to Figure 8, Jacoby discloses an endoscope comprising an image transmitting system (20c), a fiber optics bundle (18c) mounted in the endoscope (Fig.8) and

illuminating the field of view, a light source (26), and a light tapping system comprising an optical fiber that branches off of the fiber optics bundle (50) (note multiple ports 304 in Figure 9) which taps light from the fiber optics bundle and guides it to a window (aperture of optical port 304) in an external wall of the endoscope. The multiple ports (304) form a pattern (note line of ports 24 in Fig.7a). Considering fluid lumen (40) as a functional element, the windows are configured to illuminate a functional element (note close placement windows and lumen 40 in Fig.8).

Allowable Subject Matter

6. Claim 2 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

8. US 6248060 B1 Buess; Gerhard Fritz et al.
9. US 5730702 A Tanaka; Toshizumi et al.
10. US 6997871 B2 Sonnenschein; Elazar et al.
11. US 6261226 B1 McKenna; Michael A. et al.
12. US 4076018 A Heckele; Helmut
13. US 3889662 A Mitsui; Kazuhiko

Any inquiry concerning this communication or earlier communications from the examiner should be directed to John P. Leubecker whose telephone number is (571) 272-4769. The examiner can normally be reached on Monday through Friday, 6:00 AM to 2:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Linda C.M. Dvorak can be reached on (571) 272-4764. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/John P. Leubecker/
Primary Examiner
Art Unit 3739

jpl